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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,399	11/29/2000	William A. Fuss	D/99820690-009488-US(PAR)	9742

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EXAMINER

NAKHJAVAN, SHERVIN K

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/24/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,399

Applicant(s)

FUSS ET AL.

Examiner

Shervin Nakhjavan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2, 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Double Patenting

1. Claims 1-29 of this application conflict with claims 1-29 of Application No. 09/725,397. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 11, 12, 14, 15, 16 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 11, 12, 14, 15, 16 and 23, citations "adds a separate from the video signal" in claims 11 and 15 is unclear as what separate object is being added, citation "embedded" in claims 12 and 16 is unclear as what embedded object is being added, citation "said first location; and" in claim 14 seems to be referring to a previously cited location which does not appear in the claim and meets and bounds are not known, citation "said selected type of image" seems to be referring to a previously cited

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selected type of image which does not appear in the claim. Therefore, these citations are vague and confusing because, it is unclear what feature or element is referred to and further limited by this language.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 10-120, 23-27 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Kai et al. (US 5,502,575).

Regarding claims 1, 10-120, 23-27 and 29, Kai teaches, limitation of claim 1, a process comprising: detecting at a first location if a video signal represents a selected type of image (Column 4, Lines 10-43, where processing unit 10 is the first processing unit in the first location for counterfeiting detection of images to be printed which correlates the similarity of the image to be printed with the stored characteristics of currency etc.); receiving said video signal at a second location: and printing an image from said video signal at said second location if said video signal does not represent said selected type of image (Column 5, Lines 56-66, when the processing unit 10 determines that it is a valid printing and sends the signal to the circuit of second processing unit 20 which is inherently in a different location from the first unit 10 and printing is performed when no currency type image is detected);

limitation of claim 10, process further comprising: adding to said video signal a validation code at said first location if said video signal does not represent said selected type of image, and checking at said second location for said validation code (Column 6, Lines 16-66, when adding ID code X2 to the image in first unit 10 meaning image is other than a security document i.e. currency, to be printed, the ID code is detected by processing unit 20 (Figure 4, item 22) for authorization purposes to print);

limitation of claim 11, said adding step comprises adding a separate from the video signal validation code (Column 6, Lines 16-25, where X2 is the ID Code different from the video signal which is added to the image);

limitation of claim 12, said adding step comprises adding an embedded in the video signal validation code (Column 16-25, where the code will be embedded in the document inherently for future tracking of the print and the user);

limitation of claim 13, an apparatus comprising: a detector for determining if a video signal represents a selected type of image; and a corrector taking corrective act if said video signal represents said selected type of image (Column 6, Lines 16-25, where processing unit is a detector unit for detecting a currency type image and corrector unit 20 takes the corrective action by not printing if an ID Code X2 is not present in the image to be printed from the detector side output);

limitation of claim 14, said corrector comprises an adder adding a validation code to said video signal if said video signal does not represent said selected type of image, said adder being disposed at said first location (Figure 4, item 15 the adder for adding the ID code or validation code to the image to be printed and in this configuration the

corrector and the detector are within the unit 10 of the figure where item 14 is the detector and the corrector in the validation process while addition is performed);

limitation of claim 15, said adder adds a separate from the video signal validation code (Column 6, Lines 16-25, where X2 is the ID Code different from the video signal which is added to the image);

limitation of claim 16, said adder adds an embedded in the video signal validation code (Column 16-25, where the code will be embedded in the document inherently for future tracking of the print and the user);

limitation of claim 17, said corrector comprises an invalidator altering said video signal (Column 4, Lines 2-6, where adding noise is the alteration of the image to be printed which is performed by the corrector unit 20 of figure 4, item 23);

limitation of claim 18, said selected type of image represent a member of a group consisting of currency and negotiable securities (Column 3, Lines 7-13);

limitation of claim 19, apparatus further comprising; a scanner scanning an object to provide said video signal (Figure 4, Item 30 is an image scanner);

limitation of claim 20, an apparatus disposed at a second location for receiving a video signal from a first location, said apparatus comprising: a detector receiving said video signal and determining the presence of a validity code; and a printer printing a reproduction of said video signal only when said validity code is present (Figure 4, Item 20 is the apparatus disposed at second location receiving video signal from the first location item 10, detector 22 is detecting the validity code 213 and a printer 4 printing based on first condition detection of the code 213);

limitation of claim 23, said printer does not print even a partial image if said video signal represents said selected type of image (Column 4, Lines 33-54, where upon the detection of high correlation signal from the comparator 14c of figure 5 in the first location, the image will not be printed at any condition);

limitation of claim 24, said video signal is receive from a separate location (Column 4, Lines 10-17, where image sensor 30 is located next to the first processing unit 10);

limitation of claim 25, a xerographic printer disposed at a second location comprising: at least one station applying a video signal from a first location to a member; and an image processor receiving said video signal and providing it to said station only when a validation code is present (Figure 4, where combination of Items 21, 24, 26 and 27 is the image processor which upon receiving the video signal from the first location item 10 as R3, G3 and B3, performs image processing on the signal by decryption 21 and color masking 24 and further directing the signal to the station 1300 for outputting the signal to the member being the printer 4 where the original/unaltered signal is only output from the last component of the image processor (item 27) when ID code 221 is present and if not present, the video signal will have noise added to it and it is not the original signal and therefore the original video signal is output inherently only when the ID code is present;

limitation of claim 26, said validation code is present only when said video signal does not represent a member of a group consisting of currency and negotiable

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securities (Column 4, Lines 33-54, where the precondition for ID code 221 is the image being of not the currency or negotiable security type);

limitation of claim 27, said processor does not provide even a partial video signal when said code is not present (Column 6, Lines 39-53, where said code 221 is not present based on an image being of a currency type in the precondition step at location of item 10, the processor will not have a video signal to provide at all);

limitation of claim 29, the printer further comprising a plurality of stations each of said stations receiving a color component signal of said video signal (Figure 4, Items 21, 24 and 26 are the stations which receive color components of the video signal).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-3 and 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Yang et al. (US 6,516,078).

Regarding claims 1-3 and 6-9, Yang teaches, limitation of claim 1, a process comprising: detecting at a first location if a video signal represents a selected type of image; receiving said video signal at a second location: and printing an image from said video signal at said second location if said video signal does not represent said selected

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type of image (Column 5, Lines 4-26, where upon detection of selected type of image i.e. secure document, the printing is denied otherwise it is sent to a printer to print and as discussed in Column 3, Lines 28-35, the image processor 130 can be a separate device as in a computer in first location than the printer in second location);

limitation of claim 2, said selected type of image represents a member of a group consisting of currency and negotiable securities (Column 3, Lines 21-26, where there are several types of documents including banknotes, bonds etc.);

limitation of claim 3, said detecting step comprises scanning an object at said first location to produce said video signal (Column 3, Lines 28-40, where one or more components such as scanner 120, processor 130, and printer 140 could be separate or combined);

limitation of claim 6, process further comprising taking corrective action if said video signal represents said selected type of image (Column 5, Lines 22-26, where corrective action is not to print the document);

limitation of claim 7, said corrective action comprises invalidating said video signal (Column 5, Lines 22-26, where the corrective action to deny or stop the document from printing which is inherently invalidating of the document to print step);

limitation of claim 8, said corrective action comprises stopping said printing step (Column 5, Lines 22-26);

limitation of claim 9, said stopping step prevents printing even a partial image (Column 5, Lines 22-26, where deny to print is not to print any portion at all inherently).

Claim Rejections - 35 USC § 103

8. Claims 4, 5, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. in view of Roller (US 5,850,581).

Regarding claims 4, 5, 21 and 22, Kai teaches limitations of the claims substantially however, Kai does not specifically teach the printing steps being xerographically or by inkjet. Roller teaches, limitation of claims 4 and 21, said printing step comprises xerographically printing (Column 1, Lines 12-21); limitation of claims 5 and 22, said printing step comprises ink jet printing (Column 1, Lines 23-28).

It would have been obvious to an ordinary skilled in the art to use xerographical or inkjet printing capabilities of Roller with Kai's system because xerographical printing is cost effective when only black color is used and when printing in multiple colors ink jet printing is more cost effective.

9. Claims 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kai et al. in view of Lang et al. (US 5,493,381).

Regarding claim 28, Kai teaches number of ,imitations of the claim however, Kai does not specifically teach processing components of claim 28. Lang teaches, said station includes a scanner coupled to said processor, a drum disposed proximate said scanner, a development station disposed proximate said drum, and cleaner disposed proximate said drum (Column 2, Lines 46-67, where the scanner station B is coupled to the drum or belt 10, development station C is coupled to the drum 10, a cleaner station

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F is coupled to the drum 10). It would have been obvious to an ordinary skilled in the art to utilize the cleaning technique of Lang before printing because it facilitates in removing toner and additive film particle buildup on the photoconductive (i.e. imaging) member.

Other prior art cited

10. Prior art of record cited and not relied upon is considered pertinent to applicant's disclosure.

The US Patent 6,370,271; US Patent 6,289,125; US Patent 5,678,155; US Patent 5,659,628 and US Patent 5,533,144 variously teach counterfeiting preventing techniques, which are related to applicant's invention as claimed.

Contact information

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shervin Nakhjavan whose telephone number is (703) 306-5916. The examiner can normally be reached on Monday through Friday from 8:00 am to 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached at (703) 305-4706.

Any response to this action should be mailed to:

Assistant Commissioner for Patents
Washington, DC 20231

Or faxed to:

(703) 872-9306 for ***formal*** communications, please mark "**EXPEDITED PROCEDURE**"

or:

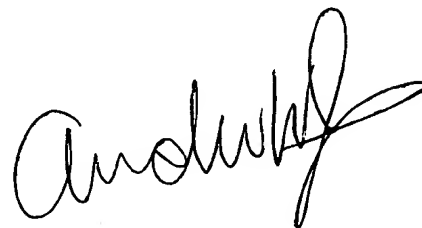
for ***informal*** or ***draft*** communications; please label "**PROPOSED**" or "**DRAFT**".

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Hand delivered responses should be brought to Crystal Park 2, 2121 Crystal drive, Arlington, VA, sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Tech center 2700 customer service office **(703) 306-0377**.

Shervin Nakhjavan S.N
Patent Examiner
Group Art Unit 2621
September 11, 2003



ANDREW W. JOHNS
PRIMARY EXAMINER